



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

Paper No. 22

Hale and Dorr LLP  
60 State Street  
Boston, MA 02109

In re Application of :  
Dekker et al. :  
Application No. 09/469,812 :  
Filed: December 22, 1999 :  
Attorney Docket No. 109846-137 :

**COPY MAILED**

**JUL 17 2002**

**OFFICE OF PETITIONS  
ON PETITION**

This is a decision on the renewed petition under 37 CFR 1.183, filed June 7, 2002, requesting waiver of 37 CFR 1.605.

The petition is **DISMISSED**.

Upon further consideration of the facts and circumstances, the Office of Petitions has determined that the Board of Appeals is the proper entity to determine the extent to which petitioner's actions should be construed as a concession or disclaimer of subject matter.

Facts:

On March 28, 2001, a non-final Office action was mailed to petitioner. The cover page stated, "A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION." The cover page stated that extensions of time were available.

The first page of the Office action suggested a claim for interference and stated, "Applicant should make the suggested claim within ONE MONTH or THIRTY DAYS from the mailing date of this letter, whichever is longer." The second page of the Office action stated that extensions of time were not available to make the suggested claim.

Therefore, the Office action set two separate time periods. One for responding to the suggested claim for interference, and a separate time period for responding to the rest of the Office action.

Petitioner failed to file an amendment adding the suggested claim within one month.

Analysis:

The present facts present issues which are appropriately under the jurisdiction of the examiner and the Board of Appeals, and not the Office of Petitions.

It is the long-established policy of the Patent and Trademark Office to maintain the line of demarcation between petitionable and appealable subject matter. See 37 CFR 1.181(a); MPEP 1201. The questions of whether or not claims are patentable or have been disclaimed relate to the merits of the invention, and the appropriate remedy for resolution of these issues ultimately lies by appeal as provided by statute, not by petition.<sup>1</sup>

---

<sup>1</sup> See e.g. In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

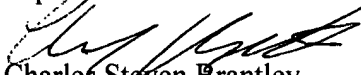
It is well settled that the Commissioner will not, on petition, usurp the functions or impinge upon the jurisdiction of the BPAI.<sup>2</sup>

The appropriateness of any forthcoming rejection<sup>3</sup> based on an Oguie concession or disclaimer, or any forthcoming interference, must be reviewed by way of appeal, not by way of petition.<sup>4</sup> The Board of Appeals is the appropriate entity to determine whether or not petitioner has conceded or disclaimed subject matter by failing to timely submit the requested amendment.

A standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing), namely absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation.<sup>5</sup> Since in this case, petitioner may appeal to the Board of Appeals, the creation of other schemes (e.g., 37 CFR 1.182 or 1.183) in order to accomplish petitioner's goals is inappropriate. It is brought to petitioner's attention that "justice" does not require an extraordinary remedy, when the rules already provide an avenue for obtaining the relief sought.<sup>6</sup> In this case, if a rejection is made, petitioner may file an appeal.

Petitioner may wish to note that an amendment adding the requested claim has still not been received by the Office. During a prior telephone conversation, petitioner informed the Office that he felt that an amendment could not be filed until the petition under 37 CFR 1.183 was granted. Petitioner was informed on the telephone that the amendment must be filed with any request for reconsideration. Therefore, even if the Office of Petitions had jurisdiction to decide the instant petition, the petition would be dismissed.

This file is being returned to Technology Center 1600 for examination in due course. Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.

  
Charles Steven Brantley  
Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

---

<sup>2</sup> See In re Dickerson, 299 F. 2d 954, 958, 133 USPQ 39, 43 (CCPA 1962); Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r Pat. 1971).

<sup>3</sup> Normally, when a claim is suggested to an applicant for purpose of interference and the applicant refuses to make it, such refusal constitutes a concession that the subject matter of the claim was the prior invention of another in this country, and thus is prior art against the applicant under 35 U.S.C. 102(g)/103. In re Oguie, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975).

If petitioner disagrees with the merits of a future rejection by the examiner, the proper step to take will be to file a Notice of Appeal and to appeal the rejection. It is the function of the Board of Appeals, not the Office of Petitions, to determine if the merits of an examiner's claim are correct.

<sup>4</sup> An example of the Board's jurisdiction in areas concerning possible disclaimer of subject matter is illustrated in MPEP 2307.02 which states, "There is an important distinction between a limited time for reply under 37 CFR 1.607(b) and a shortened statutory period under 37 CFR 1.134. The penalty resulting from failure to reply within the time limit under 37 CFR 1.607(b) is loss of the claim or claims involved, on the doctrine of disclaimer, and this is **appealable**." (emphasis added).

<sup>5</sup> See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode").

<sup>6</sup> See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pat. 1982).